


| | | | |
|---|----------------------|--------------------------------|--|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number Q78893 | |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed | |
| | 10/730,945 | December 10, 2003 | |
| | First Named Inventor | | |
| | Sugio MAKISHIMA | | |
| | Art Unit | Examiner | |
| | 2618 | Fayyaz ALAM | |
| <div style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</div> | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>60,831</u></p> <div style="text-align: right;"> _____ Signature</div> <div style="text-align: right;"> _____ Suzanne C. Walts Typed or printed name</div> <div style="text-align: right;"> _____ (202) 293-7060 Telephone number</div> <div style="text-align: right;"> _____ September 10, 2008 Date</div> | | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q78893

Sugio MAKISHIMA

Appln. No.: 10/730,945

Group Art Unit: 2618

Confirmation No.: 6289

Examiner: Fayyaz ALAM

Filed: December 10, 2003

For: MOBILE CAMERA PHONE WITH ADJUSTABLE FOCAL LENGTH

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 14, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

As a preliminary matter, Applicant notes that claims 15-27 are all the claims currently pending in the present application.

Current Claim Rejections. As of the rejection dated April 14, 2008, claims 15-17, 19-23, and 25 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication No. 2003/0040346 to Fukuda. Claims 18, 24, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fukuda in view of U.S. Publication No. 2002/0061767 to Sladen. For at least the reasons discussed below, Applicant submits that these rejections are improper, and requests reversal of the outstanding rejections.

Brief Summary of the Cited References. Fukuda discloses a portable terminal with a camera. The portable terminal includes a case that houses an image pickup device. The optical axis of the image pickup device can be aligned with the optical axis of an adapter optical system arranged in a lid member of the portable terminal. Sladen discloses a mobile phone with a camera and a mirror that provides the camera with a plurality of images.

None of the cited references, alone or in combination, teach or suggest a second refractive conversion lens that is exchangeable with a first refractive conversion lens by a sliding operation. The Examiner maintains that Fig. 18A of Fukuda discloses replacing a first refractive conversion lens with a second refractive conversion lens by a sliding operation. According to the Examiner, the adapter optical system 28 and the image pickup module 18 correspond to the claimed second refractive conversion lens, and the image pickup module 18 corresponds to the claimed first refractive conversion lens. The Examiner also asserts that the second refractive conversion lens could be arranged in either the first housing or the second housing. *See* Advisory Action dated August 1, 2008. Applicant respectfully disagrees.

Fig. 18A of Fukuda shows an embodiment of a cellular phone with a sliding lid 12 ([0151]). When the sliding lid 12 slides upward from the position shown in Fig. 18A, the optical axis of the adapter optical system 28 becomes aligned with the optical axis of the image pickup module 18. However, the adapter optical system 28 does not replace another lens; instead, it becomes aligned with the lens 18B within the image pickup module 18.

Further, Applicant disagrees with the Examiner's statement that the second conversion lens corresponds to the combination of the adapter optical system 28 and the lens of the image

pickup module 18 of Fukuda, and that the first conversion lens corresponds to the lens of the image pickup module 18 of Fukuda. Claim 15 recites that the image pickup device and the first refractive conversion lens are arranged in different housings. Because the image pickup module 18 (including the image pickup element 18A) is arranged in the case 10, the first refractive conversion lens would have to be arranged in the lid member 12 in order to meet the requirements of claim 15. Therefore, the first refractive conversion lens cannot correspond to the lens of the image pickup module 18, which is arranged in the case 10.

Also, Applicant submits that none of the other embodiments of Fukuda teaches or suggests a second refractive conversion lens that is exchangeable with a first refractive conversion lens by a sliding operation, as recited in claim 15. For example, Figs. 29A and 29B of Fukuda show an embodiment in which a first adapter optical system 28a can be replaced with a second adapter optical system 28b by rotating the lid 12 about a rotary shaft 60 (¶ [0212]). The optical axis of the first adapter optical system 28a or the second adapter optical system 28b can then be aligned with the optical axis of the image pickup module 18 by folding the lid member 12 onto the case 10 (¶ [0213]). Assuming *arguendo* that the first adapter optical system 28a corresponds to the claimed first refractive conversion lens, and that the second adapter optical system 28b corresponds to the claimed second refractive conversion lens, Figs. 29A and 29B show that the first adapter optical system 28a is not exchangeable with the second adapter optical system 28b by a sliding operation. Instead, as discussed above, the first adapter optical system 28a and the second adapter optical system 28b are exchangeable by a rotation operation about the rotary shaft 60.

Applicant submits that claim 15 distinguishes over Fukuda at least by virtue of the aforementioned differences, as well as its additionally recited features. Further, Applicant submits that dependent claims 16, 17, 19-23, and 25 distinguish over Fukuda at least by virtue of their dependencies on claim 15. Also, Sladen fails to remedy the deficient teachings of Fukuda. Therefore, claims 18, 24, and 26 are patentable over Fukuda and Sladen at least by virtue of their dependencies on claim 15, as well as their additionally recited features.

In addition, Applicant submits that the Examiner's interpretation of the claimed first and second conversion lenses is contrary to the express language recited in dependent claim 23. As discussed above, the Examiner maintains that the adapter optical system 28 and the image pickup module 18 of Fukuda correspond to the claimed second refractive conversion lens, and that the image pickup module 18 of Fukuda corresponds to the claimed first refractive conversion lens. However, claim 23 recites that the first and second refractive conversion lenses are discrete elements that are physically and optically separate from each other. Therefore, the image pickup module 18 of Fukuda cannot be an element of both the first and second refractive conversion lenses, as suggested by the Examiner.

None of the cited references, alone or in combination, teach or suggest that first and second refractive conversion lenses are mounted on a rotatable turret. As the Examiner concedes, Fukuda fails to teach or suggest this feature of claim 27. However, Sladen discloses that a circular array of mirror elements 717 are mounted on a rotatable turret (§ [0032]). The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to

incorporate the rotatable turret of Sladen into the portable terminal of Fukuda. Applicant respectfully disagrees.

According to Fukuda, the built-in camera of the portable information terminal must meet the requirement of being compact (§ [0012]). Figs. 29A and 29B of Fukuda show that the first adapter optical system 28a and the second adapter optical system 28b are widely spaced apart. Also, whichever adapter optical system that is positioned on the right-hand side of the lid member 12 must align with the camera 18 when the lid member 12 is folded on the case 10. Therefore, the proposed modification would not allow Fukuda to maintain a compact portable information terminal, because the rotatable turret would require the size of the lid member 12 to increase substantially. Therefore, the Examiner's proposed modification would be contrary to the purpose of Fukuda. Applicant submits that claim 27 is patentable over Fukuda and Sladen for at least the reasons discussed above.

Conclusion. In view of the foregoing, Applicant submits that the Examiner has failed to establish a *prima facie* case of unpatentability. Thus, claims 15-27 are patentable over Fukuda and Sladen. Applicant respectfully requests reversal of the outstanding rejections.

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Respectfully submitted,



Suzanne C. Walts
Registration No. 60,831

Date: September 10, 2008